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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,077	10/17/2001	Kevin Ronald Franklin	J3568(C)	7270

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PATENT DEPARTMENT  
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EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

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DATE MAILED: 04/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/982,077

Applicant(s)

FRANKLIN ET AL.

Examiner

EVERETT WHITE

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-51 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-51 is/are rejected.

7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some \* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 1 and 24 are objected to because of the following informalities: In Claim 1, line 1, the writing of the phrase "As a new compound" in Claim 1 is unnecessary since any claim that is drawn to a compound should be directed to a new compound. Appropriate correction is required.

In Claims 1 and 24, the term "general" in the phrase "general formula" is not limited to a specific class of compounds. The compounds of the formula are depicted, therefore, this term should be deleted.

### *Duplicate Claims*

2. Claim 51 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 50. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **Claim 1**, line 4, the term "-R-CO-" indicates that R is attached to another group other than the CO moiety. This indication does not appear to be the intent. The term "-R-CO-" should be changed to "R-CO-".

In regard to **Claim 1**, in the absence of the specific moieties intended to effectuate modification by "substitution" or attachment to the chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein Applicant fails to articulate by chemical name, structural formula or sufficiently

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distinct functional language, the particular moieties Applicant regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed. This error in Claim 1 renders Claim 1 and claims depending from Claim 1 indefinite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, **Claims 18 and 19** recite the broad recitation "the major fraction of the acylated cellobiose is the  $\alpha$  anomer", and the claims also recites "preferably at least 90% of the acylated cellobiose is the  $\alpha$  anomer" which is the narrower statement of the range/limitation.

In **Claim 21**, line 2, a word has been omitted between the terms "not" and "than" which renders the claim indefinite.

**Claim 27** is not clearly stated which renders the claim indefinite. What components of claimed invention do the terms "its" (twice) and "it" (twice) refers to?

**Claims 29 and 33** also recite broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim), which renders the claim indefinite. Claim 29 recites the broad recitation "from 0.1 to 20 % by weight", and the claim also recites "particularly from 0.5 to 15% by weight" which is the narrower statement of the range/limitation. Claim 33 recites the broad recitation "said acylated cellobiose CHME is employed in a weight ratio to said ACB of from 25:1 to 1:25", and the claim also recites "preferably from 1:1 to 1:12" which is the narrower statement of the range/limitation.

In **Claim 24**, lines 5 and 6, it is not clearly stated in the claim what the passage "being not more than a minority of X residues" is referring to, which renders the Claims 24 and claims depending from Claim 24 (See **Claims 25 and 26**) indefinite.

**Claim 32** also recites the same indefinite language. In Claim 32, lines 4 and 5, it is not clearly stated in the claim what the passage "being not more than a minority of X residues" is referring to, which renders the Claims 32 and claims depending from claim 32 (See **Claims 33-36, 38-41, and 43-49**) indefinite.

In **Claim 40**, line 2, it appears that a word or words have been omitted between the terms "comprises" and "selected" which renders the claim indefinite. Lines 2 and 3 of Claim 40 should also set forth proper Markush terminology (e.g. claim language such as "selected from the group consisting of ", for example).

In **Claims 43 and 44**, line 1 of each claim, the phrase "the or one active agent" lacks clear antecedent basis which renders the claim indefinite. What active agent is the claim referring to?

In **Claim 45**, the term "the antiperspirant salt" lacks clear antecedent basis by depending from Claim 43.

In **Claim 47**, the term "the emulsion" lacks clear antecedent basis by depending from Claim 41. **Claim 49** is rejected for the same reason since Claim 49 is dependent from Claim 47.

In **Claim 48**, the term "the emulsion" lacks clear antecedent basis by depending from Claim 46.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 28-30, 32, 37-46 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-10, 15, 21, and 23-27 of prior U.S. Patent No. 6,248,312.

This is a double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12 and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Blair (WO 99/33853).

Applicants claim an acylated cellobiose satisfying the formula set forth in Claim 1 in which X represents an acyl group –R-CO- or H, Z represents an acyl group R'-CO- or H and not more than a minority of R + R' residues represent H and in the remaining R + R' residues, R represents a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 5 to 31 carbon atoms and R' represents a residue which is different from R and which is (i) a saturated or unsaturated, linear or branched chain hydrocarbon residue containing from 1 to 31 carbon atoms optionally substituted or (ii) an aromatic hydrocarbon residue, optionally substituted or (iii) a cycloaliphatic hydrocarbon, optionally substituted. Additional limitations in the dependent claims include X representing an R-CO- group in at least 6 locations; the R residue being linear; the R residue comprising from 7 to 11 carbons and 8 or 9 carbons; the R residue being n-octyl or n-nonyl; each R residue being the same; each X representing an R-CO- group; the R' residue being alkyl residues from 1 to 6 or 11 to 24 carbon atoms, an

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aromatic residues or cycloaliphatic residues; R' being a linear alkyl residue; at least 90% of the acylated cellobiose being in the  $\alpha$  anomer form; at least 90% of the acylated cellobiose being in the  $\beta$  anomer form; not more than 50% of the Z residue represents H; and not more than 25% of the Z residue represents H.

Blair discloses the formula of a substituted cellobiose on page 8 (see Formula 4) which may be in both  $\alpha$  and  $\beta$  anomers forms and mixtures thereof (see page 6, last line) whereby one or more of the  $R_{1-8}$  of the formula may independently be selected as  $O(C=O)R_9$ , wherein  $R_9$  may be selected as a branched, saturated or unsaturated, C3 to C20 hydrocarbon. The Blair WO patent also discloses that the remainder of the  $R_{1-8}$  may be selected independently as OH groups (see the first 2 paragraphs on page 8 of the Blair WO patent). Specific examples of the  $O(C=O)R_9$  that are recited in the first paragraph of page 8 include 2,2-dimethylbutyrate, 3,3-dimethylbutyrate, and 2-ethyl butyrate which comprises the required number of carbon atoms for the acyl group set forth in the instant claims. Table 4 of the Blair WO patent discloses the compound  $\beta$ -cellobiose octapropionate, which is mentioned only to show that the Blair WO patent anticipates the instantly claimed limitation wherein each of the X symbols in the formula of Claim 1 represents an R-CO- group. The above description of the substituted cellobiose in the Blair WO patent anticipates the acylated cellobiose of Claims 1-12 and 15-21.

9. Claims 28, 30, 32, 37, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Blair (WO 99/33853).

Applicants claim a cream, soft solid or solid composition comprising a water-immiscible liquid structured or thickened by an effective amount of a gellant in which the gellant comprises an acylated cellobiose (CHME) as specified in Claim 1. Additional limitations set forth in the dependent claims include the acylated cellobiose as a major fraction of the gellant; the acylated cellobiose employed in conjunction with a gellant represented by the formula disclosed in Claim 32 wherein X represents an acyl group (R-CO-) or H and R is a hydrocarbon residue containing from 5 to 31 carbon atoms; and the composition additionally contains one or more active agents selected from skin

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benefit agents, personal care agents, medicaments, sunscreen or tanning aid; and the active agent being dissolved or suspended in a water-immiscible liquid.

The Blair WO patent discloses compositions that are in the form of solid delivery systems (see page 9, line 2) that comprises a substituted cellobiose that anticipates the acylated cellobiose that is set forth in the composition of the instant claims. See page 21, first full paragraph wherein the composition may be in the form of creams or ointments. See page 21, 2<sup>nd</sup> full paragraph wherein the composition may be applied to the skin. See page 22, 4<sup>th</sup> paragraph of the Blair WO patent wherein the substances, which can be incorporated into the delivery systems include pharmaceutical agents, therapeutic and prophylactic agents, agrochemicals such as pesticides and pheromones. See page 19, 1<sup>st</sup> paragraph of the Blair WO patent wherein the substances may be incorporated with the delivery systems in the form of a solution or as a particle suspension. The above description of a composition comprising a substituted cellobiose of the Blair WO patent anticipates the acylated cellobiose containing composition of Claims 28, 30, 32, 37, and 38.

10. Claims 50 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Blair (WO 99/33853).

Applicants claim a cosmetic use of a composition according to Claim 28 in which the composition is applied topically to skin.

The Blair WO patent discloses compositions that are in the form of solid delivery systems (see page 9, line 2) that comprises a substituted cellobiose that anticipates the acylated cellobiose that is set forth in the composition of the instant claims. See page 21, first full paragraph wherein the composition may be in the form of creams or ointments. See page 21, 2<sup>nd</sup> full paragraph wherein the composition may be applied to the skin, which anticipates the cosmetic use of the composition set forth in Claims 50 and 51.

### **Summary**

11. All the claims are rejected.



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***Examiner's Telephone Number, Fax Number, and Other Information***

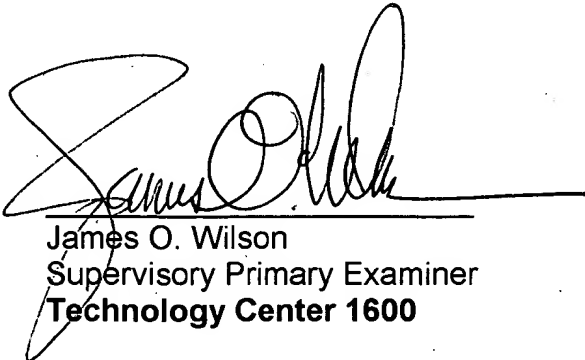
12. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at [www.uspto.gov](http://www.uspto.gov) and click on the button "Patent Electronic Business Center" for more information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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